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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/773,263	02/01/2001	Gerard K. Kunkel	WGATE11	4319
26291	7590	08/26/2004	EXAMINER	
MOSER, PATTERSON & SHERIDAN L.L.P. 595 SHREWSBURY AVE, STE 100 FIRST FLOOR SHREWSBURY, NJ 07702			BELIVEAU, SCOTT E	
		ART UNIT		PAPER NUMBER
		2614		

DATE MAILED: 08/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/773,263	KUNKEL ET AL.
	Examiner	Art Unit
	Scott Beliveau	2614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### **Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on \_\_\_\_.

2a)  This action is **FINAL**.                    2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)  Claim(s) 1-24 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1-24 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on 01 February 2001 is/are: a)  accepted or b)  objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All    b)  Some.\* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 6.  
4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: \_\_\_\_\_

## **DETAILED ACTION**

### *Priority*

1. Applicant's claim for domestic priority under 35 U.S.C. 119(e) is acknowledged.

Provisional application 60/179,736 upon which priority is claimed fails to provide adequate support under 35 U.S.C. 112 for claims 5, 6, 18, and 19 of this application. Claims 5, 6, 18, and 19, however are supported by provisional application 60/191,474. Accordingly, claims 1-4, 7-17, 20-24 shall receive the benefit of the 02 February 2000 filling and claims 5, 6, 18, and 19 shall be accorded a priority date of 23 March 2000.

### *Drawings*

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: 44 (Page 6, Line 31). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-4, 7-12, 14-17, and 20-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Wachob (US Pat No. 5,155,591) (of record).

In consideration of claims 1 and 14, the Wachob reference discloses a “system” and “method for transmitting information in a broadcast distribution system that is targeted to a system user” (Abstract). The system comprises a “network headend”, a “distribution network” [74], and a “plurality of terminal devices interfaced to said distribution network” [10] (Figures 1 and 5). The “network headend” through a “distribution network” [74] “transmits at least one information stream to a plurality of users” wherein “said information stream” is “comprised of a plurality of information selections and a plurality of corresponding codes . . . identifying a characteristic of a corresponding one of said selections that is employed to identify a system user to whom either said selection . . . or additional information should be transmitted” (Figure 3; Col 6, Lines 27-46; Col 7, Lines 18-21). The “plurality of terminal devices” [10] comprising a “terminal processor” [30] and a “user demographic database that contains demographic information about a corresponding user of said terminal device” [36] (Col 5, Line 61 – Col 6, Line 26), upon receiving the aforementioned “information stream with said codes”, “compares each code for each selection in said information stream with said demographic information in said database and

determine[s] . . . whether said user is designated to receive said selection or additional information" (Figure 3; Col 6, Line 47 – Col 8, Line 16).

Claims 2 and 15 are rejected wherein the "headend" further includes an "encoder" [66 a-N] for "generating said codes and inserting said codes into said information stream, one each before a corresponding one of said selections" (Col 10, Lines 10-19).

Claims 3 and 16 are rejected wherein the "information stream is a video information stream, said broadcast distribution system is a cable distribution system and said terminal devices are each a set-top converter" (Col 4, Lines 26-55).

Claims 4 and 17 are rejected wherein "said information selection include advertisements" (Col 4, Lines 26-55).

Claims 7 and 20 are rejected wherein "said headend includes a multiplexer" [72] for "simultaneously transmitting a plurality of said information streams on a plurality of corresponding downstream channels that are interfaced between said distribution network and said terminal devices, [wherein] each said information streams includes information selections that are targeted to different user demographics". Accordingly, each "terminal processor . . is programmed to determine a selected one of said downstream channels on which a selected information selection targeted to a user of said terminal device is to be received and accesses said selected information selection" (Figure 3; Col 6, Line 27 – Col 7, Line 12).

Claims 8, 9, 21, and 22 are rejected wherein the "terminal device" [10] further comprises a "tuner for selecting a one of said downstream channels to receive" [18] and the "terminal processor" [30] is "further programmed to instruct said tuner to tune to said selected one of

said downstream channels to receive said selected information selection” and to “instruct said tuner to tune to back to a previously selected channel after a designated one of said selections has been received” (Figure 3; Col 6, Lines 47-68; Col 7, Lines 13-54).

Claims 10 and 23 is rejected wherein the “information streams include at least one group of information selections, each selection of which is simultaneously transmitted with the other selections in said group, and is targeted to users having different demographics than those of users to which the other selections in said group are targeted” (Col 9, Line 20 – Col 10, Line 9; Col 10, Line 43 – Col 11, Line ).

Claim 11 is rejected wherein the “headend further includes an insertion module for inserting said groups of information selections into said information streams” [60] (Col 9, Lines 20-56).

Claim 12 is rejected wherein “each information selection in said groups comprises an advertisement” (Col 4, Lines 26-55).

5. Claims 1, 5, 6, 14, 18, and 19 are rejected under 35 U.S.C. 102(a) as being anticipated by Maillard et al (EP 963 119 A1).

In consideration of claims 1 and 14, the Maillard et al. reference discloses a “system” and “method for transmitting information in a broadcast distribution system that is targeted to a system user” (Abstract). As illustrated in Figure 1, the system comprises a “network headend” [110/150/170], a “distribution network” [120], and a “plurality of terminal devices interfaced to said distribution network” [160] (Paras. [0038] – [0041]). The “network headend” through a “distribution network” [120] “transmits at least one information stream to a plurality of users” wherein “said information stream” is “comprised of a plurality of

information selections and a plurality of corresponding codes . . . identifying a characteristic of a corresponding one of said selections that is employed to identify a system user to whom either said selection . . . or additional information should be transmitted" (Paras. [0025] and [0052]). The "plurality of terminal devices" [160] comprising a "terminal processor" and a "user demographic database that contains demographic information about a corresponding user of said terminal device" and upon receiving the aforementioned "information stream with said codes", "compares each code for each selection in said information stream with said demographic information in said database and determine[s] . . . whether said user is designated to receive said selection or additional information" (Figure 2; Paras. [0042] – [0044] and [0051] – [0055]).

Claims 5 and 18 are rejected wherein the "terminal processor is further programmed to provide a prompt to a corresponding user if said processor determines that said user is designated to receive said additional information" (Parad. [0045] and [0048])

Claims 6 and 19 are rejected wherein the "headend" further comprises a "database containing said additional information that is to be made available to selected system users, based on the demographic information in the user demographic database" [150] (Paras. [0040], [0046], and [0079]).

*Claim Rejections - 35 USC § 103*

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).
8. Claims 13 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wachob (US Pat No. 5,155,591), in view of Bryant et al. (US Pat No. 5,652,615).

In consideration of claims 13 and 24, the Wachob reference does not explicitly disclose nor preclude the usage of digital distribution techniques wherein “each information selection is transmitted in a different PID of a common digital channel”. The Bryant et al. reference discloses a method for delivering targeting advertising wherein “each information selection is transmitted in a different PID of a common digital channel” (Col 5, Line 41 – Col 7, Line 17). Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made so as to modify the Wachob targeted advertisement distribution for the purpose of providing a means to distribute targeted advertisements in conjunction with an upgraded (ex. analog-to-digital) distribution network (Bryant et al.: Col 1, Line 55 – Col 2, Line 14). The particular usage of digital distribution techniques as opposed to analog further provides the commonly known advantage of enabling cable distributors to carry larger numbers of programming due to more efficient utilization of bandwidth. Accordingly,

the particular usage of MPEG based distribution in conjunction with Wachob would further advantageously provide for the distribution of a greater number of commercials, hence more precisely targeted advertisements.

### *Conclusion*

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure as follows. Applicant is reminded that in amending in response to a rejection of claims, the patentable novelty must be clearly shown in view of the state of the art disclosed by the references cited and the objections made.

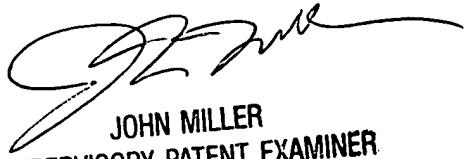
- The Picco et al. (US Pat No. 6,029,045) reference discloses a system and method for communicating a program data stream and a data stream containing targeted pieces of local content.
- The Seidman et al (US Pat No. 6,298,482) reference discloses a system and method for enabling customized content in an interactive television environment based on message filtering at the STB.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott Beliveau whose telephone number is 703-305-4907. The examiner can normally be reached on Monday-Friday from 8:30 a.m. - 6:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Miller can be reached on 703-305-4795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SEB  
August 12, 2004



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